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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,332	09/17/2003	Peter Hamilton	10121/01705	5439

7590 04/03/2007  
FAY KAPLUN & MARCIN, LLP  
Suite 702  
150 Broadway  
New York, NY 10038

EXAMINER
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PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/665,332	HAMILTON, PETER	
	Examiner	Art Unit	
	Michael B. Priddy	3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: beginning in line 1 of the specification, Applicant must update references to the continuing data to indicate that Application Serial No. 10/004,939 is now U.S. Patent No. 6,648,897 and Application Serial No. 09/456,835 is now U.S. Patent No. 6,383,198.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneebaum et al. (US 5,423,830) in view of Nakao et al. (US 5,190,542). Schneebaum et al. teach a method for removing an object from a patient comprising: inserting into the body cavity an endoscope (lines 3-8 of claim 1 of '830); advancing a flexible cup through a lumen of the endoscope in a folded insertion configuration and advancing the flexible cup distally from the lumen of the insertion device, wherein the flexible cup deploys to an operative configuration in which the flexible cup is substantially funnel shaped as it exits the lumen (lines 3-5 and 9-16 of

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claim 1 of '830); applying a vacuum pressure to an interior of the flexible cup to draw the selected portion of tissue thereinto (lines 20-24 of claim 1 of '830); positioning the endoscope to view the selected portion of tissue (lines 23-24 of column 5) and maneuvering the flexible cup relative to the endoscope (lines 17-18 of claim 1 of '830); severing the selected portion of tissue from surrounding tissue (lines 20-23 of claim 2 of '830); withdrawing the flexible cup proximally relative to the insertion device to alter a position of the selected portion of tissue relative to the insertion device while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup (lines 25-26 of claim 1 and lines 32-33 of claim 11 of '830).

Concerning the language "visually positioning the flexible cup adjacent to the selected portion of tissue," Schneebaum et al. clearly teach this action with the disclosure "to bring the opened web member 22 into juxtaposition with polyp PO," and "visually" only requires the surgeon have his eyes open which is being considered inherent. Furthermore, by observing the selected portion of tissue at least partially through the flexible cup," the Examiner has interpreted "observing" to not require visually witnessing. At lines 35-40 and 43-44 of column 5, Schneebaum has disclosed "effectively locking the polyp in the web member" and "clamping of polyp PO by ribs 26 and web member 22." It is considered inherent that the operator of the retrieval device 10 would observe the polyp tactilely through the contact of web member 22 with said polyp.

Concerning the language "fastening portions of tissue around a periphery of the selected portion of tissue," it is noted that what the portions of tissue are to be fastened

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to has not been claimed and because of this the claim merely requires these portions of tissue be fastened to something. The polyp of Schneebaum et al. is integral with portions of tissue around a periphery of the polyp and therefore fastened thereto. Upon drawing the polyp into the flexible cup, the polyp is fastened thereto and the "portions of tissue" are indirectly fastened to the flexible cup through the polyp.

Hence Schneebaum et al. teach all of the limitations of the present invention except the flexible cup being transparent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to Describe form the flexible cup disclosed by Schneebaum et al. of biologically inert flexible transparent synthetic resin or polymeric material such as polyethylene or nylon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It should be noted that Nakao et al. have disclosed a web made of "biologically inert flexible transparent synthetic resin or polymeric material such as polyethylene or nylon."

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,648,897. Although the conflicting claims are not identical, they are not patentably distinct from each other. One difference between the claims of the present invention and those of '897 is that '897, while claiming "advancing through the insertion device a substantially transparent flexible cup in a folded configuration within the insertion device" does not specifically require the cup be advanced through a *lumen*. It is considered inherent that the insertion device claimed by '897 have a lumen because some type of opening is required in order to advance any object through another object and an opening is merely a truncated or extremely short lumen. Also while the language "deploying the flexible cup from the insertion device in a substantially funnel shaped configuration" is not identical to "advancing the flexible cup distally from the lumen of the insertion device, wherein the flexible cup deploys to an operative configuration in which the flexible cup is substantially funnel shaped as it exits the lumen," when taken in combination with the language "at least partially withdrawing the flexible cup proximally" of claim 1 of '897, all the limitations of the "advancing..." step are considered met.

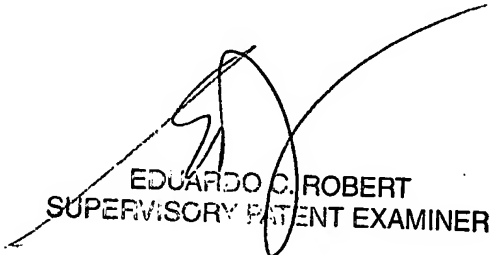
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy  
*Michael B. Priddy*  
March 30, 2007

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER